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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,906	11/21/2003	Kevin Cable	BRP-56	1643

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,906

Applicant(s)

CABLE, KEVIN

Examiner

D. Lawrence Tarazano

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11-15, 19-21, 23, 24 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 21, 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-15, 19, 20, and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed states "citrus juice" product. Citrus is a subset of all the different types of juice that can be put in a container and sold. The examiner believes that merely putting the term "juice" in the claim broadens the scope of the claims beyond what was originally provided for and supported by the specification as originally filed

1. Claims 1, 3, 4, 11, 12, 13, 14, and 5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for inorganic additives, does not reasonably provide enablement for organic additives. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

2. The applicants give clear guidance regarding the types of "inorganic" additives that can be used and provide examples of such materials.

3. This is not the case for the "organic" materials. While the applicants state in the specification how to test what materials may be suitable, they give no guidance where to start the

Art Unit: 1773

selection process. An after test to see if the materials work is just too open ended. There are millions upon millions of organic compounds to choose from.

4. Essentially one is relegated to a process of trial and error. This is clearly an undue burden.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

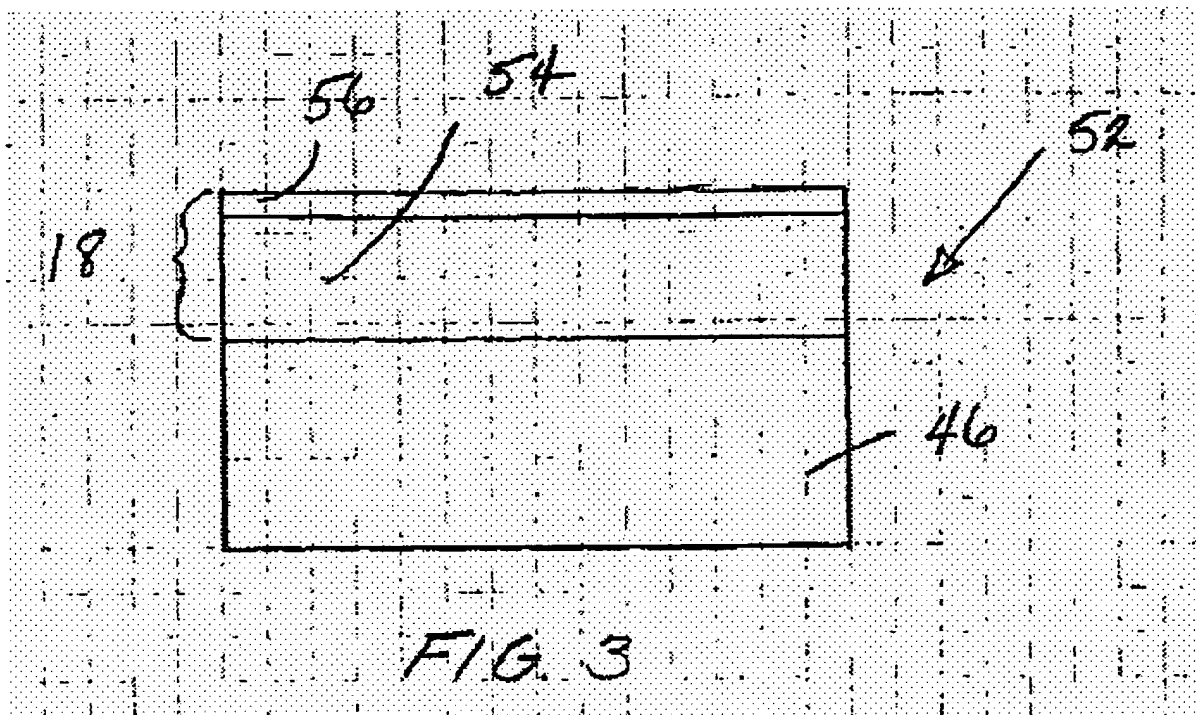
6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim depends from a canceled claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 11, 12, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gu (2002/0187333).



Gu teaches multilayer coextruded structures (18) comprising cellulose substrate (46) [0048, including paperboard]. The coextruded film (18) may contain talc or calcium carbonate [0056]. Sublayer (54) contains polypropylene materials [0050], and the surface layer (56) may contain heat sealable materials such as EXACT™ or AFFINITY™ (LLDPE, polyethylene) [0052]. It would have been obvious to one having ordinary skill in the art to have varied the amount of filler present in the films dependent of the end use of the film.

9. Claims 1-7, 11-15, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castle et al (2002/0051873).

10. Castle et al. teach paperboard packaging having a single polymer layer predominately comprising LDPE. The polymer layer may also contain filler in the blend to increase the stiffness or barrier properties of the laminate [0018]. They specifically describe a blend of

Art Unit: 1773

LDPE, nylon and calcium carbonate [0018]. Objects such as milk cartons are made from the laminate (example 3). The examiner notes that LDPE is a heat sealable material.

11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to added filler to the compositions taught by Castle et al. in order to produce carton structures with increased stiffness.

12. Regarding claim 20, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have coated both sides of the structure so that both sides of the surface would be protected from moisture. The applicants' claimed 20-35%, and this amount would be clearly possible in Castle et al. as the amount of filler is related to the stiffness of the end product and there is no showing of criticality with respect to the amount claimed.

Allowable Subject Matter

13. Claims 21, 23, and 24 are allowed. The prior art does not suggest the claimed multilayer structure having at least 3 layers on the paperboard substrate in which the surface (heat sealable layer) comprises a polyolefin coating comprising 20 to 30% of an essential oil scalping reducer comprising an inorganic additive.

Response to Arguments

14. Applicant's arguments filed 11/04/2005 have been fully considered but they are not persuasive.

15. While the applicants state that 20-35% filler is needed to provide the claimed "anti-scalping" effect, the applicant's showing is not commensurate in scope with the generic claims.

Art Unit: 1773

There are a lot of different types of fillers listed in the prior art and a number of different types of polymers, there is no indication of unexpected results for the breath of the claims.

7. The applicants state that the prior art is used for a different purpose. The prior art teaches using filler, and the examiner has provided reasons to optimize the amount of filler; the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Lawrence Tarazano

